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10/028,888	12/19/2001	Jeffrey G. Nowlin	020375-006500US	2318

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TOWNSEND AND TOWNSEND AND CREW, LLP  
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SAN FRANCISCO, CA 94111-3834

EXAMINER
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HAYES, JOHN W

ART UNIT	PAPER NUMBER
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3628

MAIL DATE	DELIVERY MODE
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03/10/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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3  
4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
6

7  
8 *Ex parte* JEFFREY G. NOWLIN, SCOTT J. SMITH, and FRED C. CASTO  
9

10  
11 Appeal 2008-2779  
12 Application 10/028,888  
13 Technology Center 3600  
14

15  
16 Decided:<sup>1</sup> March 10, 2009  
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18  
19 *Before* ANTON W. FETTING, JOSEPH A. FISCHETTI, and BIBHU R.  
20 MOHANTY, *Administrative Patent Judges*.

21  
22 FETTING, *Administrative Patent Judge*.  
23

24  
25 DECISION ON APPEAL  
26

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28 STATEMENT OF THE CASE

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

1 Jeffrey G. Nowlin, Scott J. Smith, and Fred C. Casto (Appellants)  
2 seek review under 35 U.S.C. § 134 of a non-final rejection of claims 1, 2, 4,  
3 6-16, 18-22, and 27-35, the only claims pending in the application on appeal.

4 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b)  
5 (2002).

6  
7 We REVERSE.

8 The Appellants invented a way for determining the proper postage of  
9 mailings without physically weighing each mailing (Specification 1:¶ 01).

10 An understanding of the invention can be derived from a reading of  
11 exemplary claims 1 and 15, which are reproduced below [bracketed matter  
12 and some paragraphing added].<sup>2</sup>

13 1. In a system for assembling a mailing unit for mailing,  
14 wherein the mailing unit is formed from a plurality of  
15 components including inserts and envelopes that are provided  
16 to the system; a method for producing and weighing the mailing  
17 unit, comprising:

18 [1] determining a weight for each of the components of the  
19 mailing unit and electronically storing a record of the weights at  
20 a memory in the system;

21 [2] printing at the system an identifier on one of the  
22 components forming the mailing unit after that one of the  
23 components has been provided to the system, wherein the  
24 identifier is used in identifying the components of the mailing  
25 unit;

26 [3] reading the identifier to determine the components of the  
27 mailing unit;

28 [4] placing the inserts into the envelope to form the mailing  
29 unit;

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<sup>2</sup> The claims currently entered in the record are not those in the exhibit at the end of the Appeal Brief, but rather those in the Amendment After Non-Final Rejection filed on July 1, 2004.

1 [5] determining the weight of the mailing unit based on the  
2 weights of the components utilized to form the mailing unit that  
3 are stored in the memory as a weight record.  
4

5 15. A system for producing and weighing mailing units that are  
6 formed from a plurality of components including inserts and  
7 envelopes, the system comprising:

8 [1] a controller having a processor and a memory containing the  
9 weight of each of the components;

10 [2] a printer for printing an identifier on one of the components  
11 forming the mailing unit after that one of the components has  
12 been provided to the system, wherein the identifier is used to  
13 identify the components of the mailing unit;

14 [3] a reader for reading the identifier and providing the  
15 identifier to the controller;

16 [4] a movable track;

17 [5] a plurality of inserting locations that are adapted to hold the  
18 inserts, and a plurality of inserting mechanisms that are adapted  
19 to place selective ones of the inserts onto the track; and

20 [6] a moving mechanism that is adapted to move the inserts  
21 from the track and into an envelope to form a mailing unit;

22 [7] wherein the controller is configured to determine the  
23 components of the mailing unit based on the identifier and to  
24 determine the weight of the mailing unit based on the weights  
25 of the components utilized to form the mailing unit that are  
26 stored in the memory.  
27

28 This appeal arises from the Examiner's Non-Final Rejection, mailed  
29 May 4, 2004. The Appellants filed an Appeal Brief in support of the appeal  
30 on July 1, 2004. An Examiner's Answer to the Appeal Brief was mailed on  
31 September 13, 2007. A Reply Brief was filed on November 9, 2007.

PRIOR ART

The Examiner relies upon the following prior art:

Long	EP 0 621 563 A1	Oct. 26, 1994
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REJECTION<sup>3</sup>

Claims 1, 2, 4, 6-16, 18-22 and 27-35 stand rejected under 35 U.S.C. § 102(b) as anticipated by Long.

ISSUE

The issue pertinent to this appeal is whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 1, 2, 4, 6-16, 18-22 and 27-35 under 35 U.S.C. § 102(b) as anticipated by Long.

The pertinent issue turns on whether Long describes limitation [2] of printing at the system an identifier on one of the components forming the mailing unit after that one of the components has been provided to the system, wherein the identifier is used in identifying the components of the mailing unit; and [3] of reading the identifier to determine the components of the mailing unit.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

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<sup>3</sup> The rejection in the Answer omits claim 4 (Answer: 4), but claim 4 is included in the rejection in both the Non-Final Rejection at 3 and the Brief at 2. Accordingly, the omission in the Answer is taken to be a typographic error and claim 4 is included within the scope of the rejection for the purposes of this appeal.



1 must do so by placing such definitions in the specification with sufficient  
2 clarity to provide a person of ordinary skill in the art with clear and precise  
3 notice of the meaning that is to be construed. *See also In re Paulsen*, 30  
4 F.3d 1475, 1480 (Fed. Cir. 1994) (although an inventor is free to define the  
5 specific terms used to describe the invention, this must be done with  
6 reasonable clarity, deliberateness, and precision; where an inventor chooses  
7 to give terms uncommon meanings, the inventor must set out any  
8 uncommon definition in some manner within the patent disclosure so as to  
9 give one of ordinary skill in the art notice of the change).

#### 10 *Anticipation*

11 "A claim is anticipated only if each and every element as set forth in the  
12 claim is found, either expressly or inherently described, in a single prior art  
13 reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628,  
14 631 (Fed. Cir. 1987). "When a claim covers several structures or  
15 compositions, either generically or as alternatives, the claim is deemed  
16 anticipated if any of the structures or compositions within the scope of the  
17 claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351 (Fed.  
18 Cir. 2001). "The identical invention must be shown in as complete detail as  
19 is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d  
20 1226, 1236 (Fed. Cir. 1989). The elements must be arranged as required by  
21 the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology  
22 is not required. *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

#### 24 ANALYSIS

25 *Claims 1, 2, 4, 6-16, 18-22, and 27-35 rejected under 35 U.S.C. § 102(b) as*  
26 *anticipated by Long.*

1 Independent claim 1 is directed toward a method and independent  
2 claim 15 is directed toward a system. The Examiner treated claim 15 as  
3 representative of the group of claims and found that Long anticipated claim  
4 15 (Answer 3-4). The Appellants contend that Long does not describe  
5 limitation [2] of printing at the system an identifier on one of the  
6 components forming the mailing unit after one of the components has been  
7 provided to the system, wherein the identifier is used in identifying the  
8 components of the mailing unit; and [3] of reading the identifier to  
9 determine the components of the mailing unit.

10 We agree with the Appellants. The Examiner found that in a system  
11 claim, anticipation requires the capacity for intended use, not the  
12 performance (Answer 5). The Examiner failed to show that Long has such a  
13 capacity.

14 The Examiner's findings are that the identifier printed by Long is a  
15 credit card number or driver license number or other identifying information  
16 (Answer 3). Long does indeed print such identifiers (FF 04). Long's reader  
17 does not read these identifiers, however. Instead, Long's reader (Long Fig  
18 2:34) reads data cards that have identifiers pre-stored in computer readable  
19 format (FF 02 & 03). The Examiner identifies Long's z-fold sheet sensor  
20 (Long Fig 2:66) and web section sensor (Long Fig. 2:27) as such readers, but  
21 these are sensors for manipulating the sheets and there is no evidence they  
22 possess the capacity for reading identifiers.

23 The Examiner found that Long's identifier was information in a data  
24 record (Answer 5). This is not the identifier required by each of the  
25 independent claims. Each independent claim requires that the identifier that  
26 is read and that is used to determine weight be the same identifier that was



1 printed by the printer. Long does not do so and the Examiner has not shown  
2 otherwise. The information on Long's data cards, which would be the  
3 information in a data record found by the Examiner, is not printed by Long's  
4 printer. Thus, Long does not exhibit the capacity to perform any of the  
5 independent claims.

6  
7 **CONCLUSIONS OF LAW**

8 The Appellants have sustained their burden of showing that the  
9 Examiner erred in rejecting claims 1, 2, 4, 6-16, 18-22, and 27-35 under 35  
10 U.S.C. § 102(b) as anticipated by Long.

11  
12 **DECISION**

13 To summarize, our decision is as follows:

- 14 • The rejection of claims 1, 2, 4, 6-16, 18-22, and 27-35 under 35  
15 U.S.C. § 102(b) as anticipated by Long is not sustained.

16  
17 **REVERSED**

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